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Re: Application No. 10/031,942 - response to non-final rejection after appeal

Dear John Hotaling, ✓

This is in response to the communication of 11/12/2004 concerning application 10/031,942. I would like to request that you reconsider this application, with the amended claims that I attach, and in the light of my comments below.

In the following text I first explain the amendments to the claims in section (a), then discuss the double patenting rejection and provisional rejections in section (b), and then respond to your argument about Weiner *et al* in view of Lites out! in section (c).

It is not obvious to me what is supposed to be the status of Claim 4 now. In the action summary it is marked as rejected, but the action does not include any argument against my argument in section (8)(d) of the appeal brief. That needs to be clarified.

It is also not obvious to me why I get now a standard non-final rejection, without "resumption of execution". I thought it is going to the board of patent appeals and interferences. I will be grateful if the formal status of the application can be made clearer.

I attach amended claims, and a terminal disclaimer with respect to Harpaz 6,568,683.

(a) The Amended Claims

(a.1) To make it clear that there are two different patterns, I have added two lines to Claim 5 stating this point, and then refer to the patterns that these two lines mention in the following text. The two lines are a summary of the first 10 lines of page 4 of the description, where it talks about two "rules", and then explains (line 9) that each rule specifies a pattern. The two patterns are the two "rules" (i.e. patterns) (a) and (b) in lines 3-8.

(a.2) Note that in the previous version of Claim 5, it referred to "a fixed pattern" and then to "another fixed pattern", which clearly means two patterns.

(a.3) I have also added a line saying that the board keeps the "current player colour". That is based on the second paragraph of page 7 of the description, where it is called current_player. Note that all that this record is doing is switching each turn between the colours.

(b) Double patenting

(b.1) Double patenting rejection with respect to Harpaz 6,568,683: I don't agree with the examiner, but anyway I attach a terminal disclaimer to overcome the rejection.